

Appl. No.: 09/869,745  
Response to Office communication of: 4/10/2003  
docket no.: DEXNON/095/PC/US

## REMARKS

No claims have been added, cancelled or amended. Claims 22-44 are pending in the application.

### The rejection of claim 22-36 under 35 U.S.C. §112, second paragraph.

Claims 22-36 were rejected under 35 USC §112, second paragraph, as allegedly being indefinite. More particularly, the Office communication states that: "it is unclear if the Applicant is claiming the nonwoven web material comprising cellulosic and synthetic fibers and the web material comprising only cellulosic fibers."

Claim 22 recites: "A nonwoven web material comprising cellulosic and synthetic fibres, . . .". Claim 22 is clearly directed to a nonwoven web material comprising cellulosic and synthetic fibers. Claim 22 goes on to recite: "wherein the web material exhibits lower cross direction wet expansion than a similar web material comprising only the same cellulosic fibres." This recitation is a comparison of the properties of the inventive cellulosic and synthetic fiber web material to a different web material comprising only cellulosic fibers. The comparative web material comprising only cellulosic fibers is not part of the invention.

The legal precedent on claim language is summarized MPEP §2173.01. That section states:

"A fundamental principal contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which protection is sought."

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Further, as stated by the Court in Miles Laboratories Inc. v. Shandon Inc., 27 USPQ2d 1123, 1126 (Fed. Cir. 1993), "If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, §112 demands no more."

The Examiner correctly interpreted claim 22 as being directed to a web material comprising both cellulosic and synthetic fibers. Thus, it would appear that claim 22 is definite enough to satisfy MPEP §2173.01 and 35 USC §112, second paragraph. Claims 29 and 34 use similar language and are similarly definite. Applicant would consider any suggestions from the Examiner on how to further clarify these claims.

**The rejection of claims 37-41 under 35 U.S.C. §102(b).**

Claims 37-41 were rejected under 35 U.S.C. §102(b) as having each and every feature and interrelationship anticipated by European Patent No. EP 712,889 A2 to DuCharme.

**• Applicant's claim elements are not found in DuCharme.**

Claim 37 recites in one pertinent part: "A casing paper . . . which casing paper contains a web material comprising cellulosic fibres and synthetic fibres . . ." Thus, Applicant's claim 37 requires "cellulosic fibres" as well as synthetic fibers. The DuCharme reference discloses a dope made up by dissolving cellulose in an amine oxide solvent (page 3, lines 49-50) and adding a second fibrous material that becomes partly solubilized in the dope. The DuCharme reference teaches that the cellulose is fully dissolved in the dope. See column 4, lines 12-13: "Other fibers are fully dissolved and therefore not visible under the microscope." There is no apparent teaching in the DuCharme reference of a "web material comprising cellulosic fibres and synthetic fibres" as recited in Applicant's claims 37-41. Claims 37-41 are not anticipated by the DuCharme reference and are patentable for at least this reason.

**• The reasoning used in th Offic communication is flawed.**

The Office communication asserts: "It should be noted that the finished article

can be treated with a crosslinking agent, increasing the dimensional stability of the article to approximately the same as, and in many cases greater than, that seen in conventional fibrous casing (page 3, lines 55-58)."

The DuCharme reference at page 8, lines 45-48 explicitly teaches that nylons and polyolefins are insoluble in amine oxide solutions. The DuCharme reference at page 4, lines 24-32 states:

It has been found that articles can be made of a compounded fibrous dope composition similar to the above, but which differs in that the second fibrous material is not wettable or plasticized by aqueous amine oxide into the cellulose matrix. . . . Whether or not the final articles are treated with crosslinking agent, they will have less dimensional stability, than their conventional fibrous casing counterparts, . . . This composition is made as described for the composition above, but fibers that are not soluble in aqueous amine oxide and are not wettable by this solvent are used as the second fibrous material . . .

Thus, when synthetic fibers such as nylon or polyolefin are used in the DuCharme material the result is a web with "less dimensional stability" than Applicant's fibrous casing. Contrary to the Office communication use of synthetic fibers in the DuCharme material reduces the dimensional stability of the web. Claims 37-41 are not anticipated by the DuCharme reference and are patentable for at least this reason.

- **The reasoning used in the Office communication does not provide the legally required basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art.**

The Office communication also asserts, with bolding added: "If the dimensional stability of an article increases, the article is **likely** to have a lower cross direction wet expansion." Thus, the Office communication merely speculates as to the relationship between dimensional stability and cross direction wet expansion.

"Anticipation of inventions set forth in product claims cannot be predicated on mere conjecture respecting the characteristics of products that might result from the

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practice of processes disclosed in the references." Phillips Petroleum Co. v. U.S. Steel Corp., 6 USPQ2d 1065, 1076-1077 n12 (D. Del. 1987), aff'd 9 USPQ2d 1461 (Fed. Cir. 1989). To rely on the theory of inherency in rejecting a claim under 35 U.S.C. 102 or 103, " . . . the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art.". See Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The DuCharme reference does not disclose improvement of cross direction wet expansion properties. Applicant respectfully traverses the above Office communication assertion as speculative and unsupported, especially in view of the explicit teachings within DuCharme as to lessening web dimensional stability by using synthetic materials. If this assertion is maintained it should be accompanied by the required "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art". Claims 37-41 are not anticipated by the DuCharme reference and are patentable for at least this reason.

**The rejection of claims 42-44 under 35 U.S.C. §102(a) or §102(e).**

Claims 42-44 were rejected under 35 U.S.C. §102(b) or §102(e) as having each and every feature and interrelationship anticipated by U. S. Patent No. 5,942,354 to Oxley et al.

- **Applicant's claim elements are not found in the Oxley reference.**

Applicant's claims 42-44 are directed to a process for preparing "casing paper". There is no teaching or suggestion that the battery separator of Oxley is, or can be, a food casing web. There is no teaching or suggestion in the Oxley reference that the Oxley process can be used to prepare a food casing web.

The Office communication admits that "Oxley is directed to a curl resistant battery separator." The communication goes on to state: "Oxley is directed to a curl

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resistant battery separator (Abstract). Oxley notes that a variety of materials have been used as battery separators such as fiber-reinforced generated cellulose (sausage casings) (column 1, lines 29-34)." The communication admits that the Oxley reference is directed to battery separator materials. The Office communication does NOT point out where the Oxley reference discloses the manufacture of food casing webs as recited in Applicant's claims. The Office communication does not explicitly recite on the record that battery separator materials must be equivalent to food casing webs.

As discussed below, there is NO two way equivalence between food casings and battery separator material, that is, while sausage casing web may be used as battery separator material, there is NO teaching or suggestion that the Oxley battery separator material can be used as a food casing. Applicant respectfully traverses this rejection. Claims 42-44 are not anticipated by the Oxley reference and are patentable for at least this reason.

- **The reasoning used in the Office communication is flawed.**

The Office communication asserts that: "Oxley notes that a variety of materials have been used as battery separators such as fiber-reinforced generated cellulose (sausage casings) (column 2, lines 18-40). " Thus, while admitting that the Oxley reference does not teach or suggest food casing webs or methods of making food casing webs, the Office communication attempts to equate a disclosure of the use of a sausage casing as a battery separator with an undisclosed use of battery separators for sausage casings. That is, the communication implicitly speculates, without statement on the record and without reasoning, that if a sausage casing = a battery separator than a battery separator MUST = a food casing.

The text of column 2, lines 18-40 of Oxley cited by the communication state:

A variety of materials have been used as battery separators. Various dry cell and storage batteries have employed wheat flour and cornstarch paste, paper, wood veneer, hard rubber, porous rubber, celluloid, glass mats, regenerated cellulose and fiber-reinforced regenerated cellulose (sausage casings). A variety of materials have been explored for use as battery separators including polyvinyl alcohol, methyl cellulose,

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polypropylene, fiberglass, and crosslinked methacrylic acid grafted polyethylene.

Under the communication logic, the other materials mentioned as used for battery separators should also be suitable for use as a food casing web material. Clearly, a sausage wrapped in a wood veneer or hard rubber or glass mat casing would not be acceptable.

Further, the qualities explicitly mentioned as desirable for battery separator materials by the Oxley reference at column 1, lines 37-48 are not useful to food casing webs.

These separators are used to separate the positive and negative electrodes of a cell to prevent short circuits. Separators should distribute and retain electrolyte between the electrodes while preventing dendritic growths or soluble products from shorting the cell or migrating to an opposing electrode. Desirably, separators will: be stable in the cell environment resisting degradation by cell media; permit conduction across the separator of current transferring ions or charges; be capable of operation under conditions of use including desired operating temperatures, pressures, and forces; and be easily and economically fabricated into electric cells.

Additionally, the Oxley reference at column 2, lines 34-42 states that the material is stabilised against curling by "drying the coated substrate under biaxial tension" followed by "holding the separator for at least 8 hours at an elevated temperature of at least 40 °C in the presence of a controlled amount of moisture". It cannot be deduced from the Oxley patent what level of wet cross direction expansion the battery separator material will have. This text again demonstrates that there is no simple equivalence between food casing web and battery separator material.

Contrary to the speculations of Office communication, the Oxley battery separator material is NOT taught or suggested to be an equivalent to a food casing web. Claims 42-44 are not anticipated by the Oxley reference and are patentable for at least this reason.

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- The reasoning used in the Office communication does not provide the legally required basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art.

"Anticipation of inventions set forth in product claims cannot be predicated on mere conjecture respecting the characteristics of products that might result from the practice of processes disclosed in the references." Phillips Petroleum Co. v. U.S. Steel Corp., 6 USPQ2d 1065, 1076-1077 n12 (D. Del. 1987), aff'd 9 USPQ2d 1461 (Fed. Cir. 1989). To rely on the theory of inherency in rejecting a claim under 35 U.S.C. 102 or 103, " . . . the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art.". See Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The Oxley reference does not disclose materials suitable for food casing webs or methods of making materials suitable for food casing webs. Applicant respectfully traverses the above Office communication assertion as speculative and unsupported. If this assertion is maintained it should be accompanied, on the record, by the required "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art". Claims 42-44 are not anticipated by the Oxley reference and are patentable for at least this reason.

**The rejection of claims 22-24, 28-29 and 31-36 35 U.S.C. §102(b) or alternatively §103(a).**

Claims 22-24, 28-29 and 31-36 were rejected under 35 U.S.C. §102(b) as having each and every feature and interrelationship anticipated, or alternatively under 35 USC §103(a) as being obvious over, U. S. Patent No. 5,942,354 to Oxley et al.

- **Applicant's claim elements are not found in the Oxley reference.**

Applicant's claim 22 recites: "A nonwoven web material comprising cellulosic and synthetic fibres, wherein the web material exhibits lower cross direction wet expansion than a similar web material comprising only the same cellulosic fibres." The Office communication asserts that: "Although Oxley does not explicitly teach the claimed lower cross direction wet expansion than a similar web material comprising only the same cellulosic fibers, it is reasonable to presume that the claimed lower cross direction wet expansion than a similar web material is inherent to Oxley. Support for said presumption is found in the use of like materials . . . which would result in the claimed property."

- The Oxley reference at column 2, lines 34-42 states that the material is stabilised against curling by "drying the coated substrate under biaxial tension" followed by "holding the separator for at least 8 hours at an elevated temperature of at least 40 C in the presence of a controlled amount of moisture".
- The Oxley reference at column 11, lines 51-65 states, with bolding added:

Typically the end of the roll of the separator on the reel 37 is taped to the roll to prevent unwinding and the reeled roll of separator is placed in a plastic bag(not depicted) which acts as a water barrier. The bag is closed around the roll and the open end folded or otherwise closed to prevent moisture loss. The enclosed reel is then held in a "hot room" for at least 8 hours at an elevated temperature of at least 40 °C, preferably at least 45 °C. The moisture level is controlled by enclosure within the closed plastic bag which acts as a moisture barrier so that the total moisture level which was previously adjusted to 4 to 25 (preferably 4 to 12) weight percent based upon the bone dry gauge of the separator does not change. **This holding step**, which is referred to and defined here as an annealing step, **stabilizes the separator's lay flat properties against curling . . .**
- The Oxley reference at column 12, lines 19-21 states: "Longer holding periods and/or higher temperatures may improve reduction of curl."
- The Oxley reference in EXAMPLES 13-14 explicitly teaches that battery

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separator materials having slight to severe curl had that curl removed by holding the same material in closed plastic bags held at 47 °C for 16 hours.

In sum, and contrary to the communication assertion, Oxley explicitly teaches that “curling” is a function of processing and NOT of material composition. It cannot be deduced from the Oxley patent what level of wet cross direction expansion the battery separator material will have. Claims 22-24, 28-29 and 31-36 are not anticipated by, or obvious over, the Oxley reference and are patentable for at least this reason. Applicant respectfully traverses the communication presumption and asserts that, if maintained, this presumption be supported on the record in view of 1) the explicit teaching in the Oxley reference that process and NOT material is responsible for “curling” and 2) the lack of disclosure in the Oxley reference of wet expansion profile or improvement in wet expansion profile.

- **The reasoning used in the Office communication does not provide the legally required basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art.**

“Anticipation of inventions set forth in product claims cannot be predicated on mere conjecture respecting the characteristics of products that might result from the practice of processes disclosed in the references.” Phillips Petroleum Co. v. U.S. Steel Corp., 6 USPQ2d 1065, 1076-1077 n12 (D. Del. 1987), aff’d 9 USPQ2d 1461 (Fed. Cir. 1989). To rely on the theory of inherency in rejecting a claim under 35 U.S.C. 102 or 103, “ . . . the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art.”. See Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

The communication asserts that “it is reasonable to **presum** ” that Applicant’s claimed lower cross direction wet expansion is inherently present in the Oxley web

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material. However, for inherency to apply the “allegedly inherent characteristic” must “necessarily flow from the teachings of the applied art.” Clearly, the “reasonable to presume” assertion falls far short of the legally required certitude. This is especially true when, as in the present case, the cited reference explicitly teaches that curling is reduced NOT by material variations but by the recited processing. Applicant respectfully traverses the above Office communication assertion as speculative and unsupported. If this assertion is maintained it should be accompanied, on the record, by the required “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art” in view of the explicit teachings in the Oxley reference. Claims 22-24, 28-29 and 31-36 are not anticipated by, or obvious over, the Oxley reference and are patentable for at least this reason.

- **Claim 33 is not anticipated for additional reasons.**

Claim 33 recites in one pertinent part: “The method of claim 29 further comprising . . . to form a casing material adapted for the packaging of food products.”

As discussed above the Office communication admits that the Oxley reference is directed to battery separator materials and does NOT point out where the Oxley reference discloses the manufacture of food casing webs as recited in Applicant’s claims. As also discussed above, there is NO two way equivalence between food casings and battery separator material, that is, while sausage casing web may be used as battery separator material, there is NO teaching or suggestion that the Oxley battery separator material can be used as a food casing. Applicant respectfully traverses this rejection. Claim 33 is not anticipated or obvious over the Oxley reference and is patentable for at least this additional reason. Claims 34-36 recite similar features and are additionally patentable for similar reasons.

- **Claim 36 is not anticipated for additional reasons.**

Claim 36 recites: “The web material of claim 34 in which drying of the web

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material is effected by a plurality of heated cylinders."

The Office communication asserts, with bolding added: "As to claims 34-36, the processes of . . . 'drying of the web material by a plurality of heat cylinders' are not given any patentable weight **because they have no impact on the final product.**" Applicant's specification at page 1, lines 13-29 explicitly addresses the impacts different drying methods will have on the final web product. Further, and as discussed above, the Oxley reference is directed to a specific method of drying a battery separator material to impact the final properties of that separator material. Thus, contrary to the communication assertions, both Applicant's specification and the cited Oxley reference explicitly teach that drying methods DO have an impact on the final product. The communication admits that the Examiner improperly examined claim 36 in view of the teachings in both Applicant's specification and the cited reference. Applicant respectfully traverses this rejection. Claim 33 is not anticipated or obvious over the Oxley reference and is patentable for at least this additional reason.

**The rejection of claims 25-27 and 30 under 35 U.S.C. §103(a).**

Claims 25-27 and 30 were rejected under 35 USC §103(a) as being obvious over U. S. Patent No. 5,942,354 to Oxley et al.

As stated in MPEP §2143, to establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

**•     Applicant's claim elements are not found in the Oxley reference.**

As discussed above the recited "lower cross direction wet expansion than a similar web material comprising only the same cellulosic fibres" found in Applicant's claims 22 and 29, and therefore also in claims 25-27 and 30 dependent therefrom, is

not taught or suggested by the Oxley reference. Claims 25-27 and 30 are not obvious over the Oxley reference and are patentable for at least this reason.

As discussed above, the Oxley reference explicitly teaches a specific process for limiting curl of battery separator material. Applicant's method and material does not rely on or require the specific process taught by Oxley.

As stated in MPEP §2144.04(b), the omission of an element and retention of its function is an indicia of unobviousness. Applicant has respectfully asserted that there is no evidence of record showing that the battery separator material curl in Oxley is equivalent to the claimed cross direction wet expansion. Arguendo, if battery separator material curl is equivalent to cross direction wet expansion, than the improvement of web material cross direction wet expansion without the use of the specific Oxley process is a further indication of the unobviousness of Applicant's claims. Claims 25-27 and 30 are not obvious over the Oxley reference and are patentable for at least this additional reason.

- **Claims 26-27 are not obvious for additional reasons.**

Claim 26 recites: "The web material of claim 22 in which the synthetic fibres comprise from 0.5 to 20% by weight of a total weight of cellulosic and synthetic fibres."

The Oxley reference states, with bolding added: "Battery separators of a nonwoven substrate of **noncellulosic fibers** extrusion coated on at least one surface with a cellulosic film are disclosed . . ." (column 2, lines 18-20); "According to the present invention a curl resistant battery separator is provided having a nonwoven substrate of **noncellulosic fibers** with the substrate extrusion coated on at least one surface with a cellulose film." (column 4, lines 11-14); "Instead, the invention coats a **noncellulosic nonwoven** with a liquid, plastified or extrudable cellulosic solution which is then solidified . . ." (column 4, lines 16-19); and "Preferably, the **noncellulosic fibers will comprise at least 50% by weight**, more preferably at least 60% still more preferably at least 75% of the nonwoven substrate. In some preferred embodiments, the **nonwoven substrat compris s at least 95 weight % of noncellulosic fibers**. In

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an especially preferred embodiment, a nonwoven substrate having at least 95 weight % polyamide fibers are used." (column 6, lines 11-19). The Oxley reference teaches that at least 50% by weight of the battery separator will be noncellulosic (synthetic) fibers. The Oxley reference does NOT teach or suggest the use of less than 50% by weight synthetic fibers and especially not the use of 0.5% to 20% by weight of synthetic fibers. Claim 26 is not obvious over the Oxley reference and is patentable for at least this additional reason. Claim 27 recites similar features and is additionally patentable for similar reasons.

- **The communication reliance on the cited Boesch case is misplaced.**

The Office communication, apparently attempting to address the fact that the synthetic fiber ranges in Applicant's claims and the Oxley reference do not overlap, states:

It should be noted that the amount of cellulosic and synthetic fibers in the fibrous web are result effective variables; for example, as the amount of cellulosic fibers increases, the web will become more paper-like. It would have been obvious to one having ordinary skill in the art at the time the invention was made to Oxley, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

The citation referred to in the communication, at 205 USPQ 215, 219 (CCPA 1980), states:

[1] In the above-quoted passage from '838, we note that lowering the N<sub>v</sub> value of a Co-Cr-Ni alloy and depletion of the metals not consumed in precipitation from the N<sub>v</sub> calculation are expressly suggested. Considering, also, that the composition requirements of the claims and the cited references overlap, we agree with the Solicitor that the prior art would have suggested "the kind of experimentation necessary to achieve the claimed composition, including the proportional balancing described by appellants' N<sub>v</sub> equation." This accords with the rule that discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art.

Thus, the decision in the Boesch case relied on 1) the cited reference "expressly"

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suggesting the relationship between the variable and the result; 2) the claimed ranges and cited reference ranges overlapping; and 3) the prior art suggesting "the kind of experimentation necessary to achieve the claimed composition . . . described by appellants. The facts of the present situation are completely different from the facts of Boesch.

- There is no teaching or suggestion in Oxley of lowering cross direction wet expansion profile in a web material.
- There is no teaching or suggestion in Oxley that synthetic fiber concentration effects battery separator curling. The Oxley reference DOES teach that specific process variations effect battery separator curling.
- The Oxley reference does teach use of "at least 50% by weight " of noncellulosic fibers in the battery separator material. In fact, as discussed above the Oxley reference strongly teaches that use of substantially more than 50% synthetic fibers is preferred.
- The Oxley reference does not teach or suggest use of synthetic fibers at about 0.5% to about 20% as recited in Applicant's claims. There is no overlap between the claimed amounts and the amounts taught in Oxley as required or preferred.
- Given the teaching in Oxley that 50% synthetic fibers is a minimum and at least 95% synthetic fibers is preferred or especially preferred (Oxley, column 6, lines 14-18) a person of ordinary skill would be taught away from "the kind of experimentation necessary to achieve the claimed composition" of Applicant's.

Applicant traverses the communication statement that "the amount of cellulosic and synthetic fibers in the fibrous web are result effective variables" under Boesch in view of the contrary teachings of the cited Oxley reference.

As stated by the courts in In re Lee, 61 USPQ2d, 1430 (Fed. Cir. 2002):

The determination of patentability on the ground of unobviousness is ultimately one of judgment. In furtherance of the judgmental process, the patent examination procedure serves both to find, and to place on the official record, that which has been considered with respect to

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patentability. [When] the examiner and the Board . . . rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

If the Examiner maintains the position that “the amount of cellulosic and synthetic fibers in the fibrous web are result effective variables”, the Examiner is respectfully requested to provide a specific statement supporting this assertion. If this statement by the Examiner is not found in prior art reference(s), and is instead based on the knowledge of the Examiner, then the Examiner is requested to supply an affidavit conforming to 37 C.F.R. §1.104(d)(2).

- **There is no suggestion or motivation to modify the Oxley reference.**

A reference that teaches away from a claimed invention does not provide the suggestion or motivation needed to anticipate or make obvious a claimed invention. In fact, the courts have stated that a reference that teaches away from a claimed invention is an indication of the nonobviousness of that invention. “A reference, however, must have been considered for all it taught, disclosures that diverged and taught away from the invention at hand as well as disclosures that pointed towards and taught the invention at hand.” Ashland Oil, Inc. v. Delta resins & Refractories, Inc., 227 USPQ 657, 666 (Fed. Cir. 1985). “One important indicium of nonobviousness is ‘teaching away’ from the claimed invention by the prior art.” In re Braat, 16 USPQ2d 1813, 1814 (Fed. Cir. 1990). The prior art reference must be considered in its entirety, including portions that would lead away from the claimed invention. See MPEP 2141.02.

The Oxley reference teaches that at least 50% by weight, and more preferably 95% by weight, of the battery separator will be noncellulosic (synthetic) fibers. This teaching in Oxley is away from the Applicant’s claimed use of about 0.5% to about 20% by weight of synthetic fibers. Claim 26 is not obvious over the Oxley reference and is

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patentable for at least this additional reason. Claim 27 recites similar features and is additionally patentable for similar reasons.

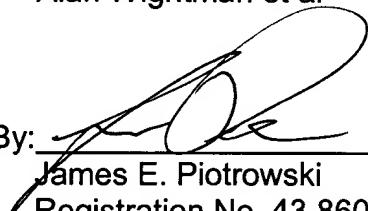
In summary, Applicants have addressed each of the objections and rejections within the present Office Action. It is believed the application now stands in condition for allowance, and prompt favorable action thereon is respectfully solicited.

The Examiner is invited to telephone Applicant(s)' attorney if it is deemed that a telephone conversation will hasten prosecution of this application.

Respectfully submitted,

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